



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/545,015

04/07/2000

Seth Haberman

0813808.12201

9448

545 7590 04/15/2009

IP Patent Docketing
K&L GATES LLP
599 Lexington Avenue
33rd Floor
New York, NY 10022-6030

EXAMINER

BAIG, SAHAR A

ART UNIT

PAPER NUMBER

2424

MAIL DATE

DELIVERY MODE

04/15/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/545,015	Applicant(s) HABERMAN ET AL.	
	Examiner SAHAR A. BAIG	Art Unit 2424	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/02/2009 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1 and 3-13 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 10-13 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of In Re Bilski 88 USPQ2d 1385. The instant claims are neither positively tied to a particular

machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The advertising method including steps of obtaining user profile and selecting an advertising template using expert rules is broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 1 and 3-13 rejected under 35 U.S.C. 103(a) as being unpatentable over Slade et al. US Patent No. 5,550,735 in view of Foresman et al. US Patent No. 5,099,422.

Regarding claim 1, 10, 11 and 13, Slade discloses a system for dynamically constructing a non-interactive personalized advertisement to be viewed by an intended audience, comprising: an advertisement template **Figure 3-6**, defining a framework for constructing said personalized advertisement, said advertisement template comprising a plurality of media segment slots (*ten seconds intervals of*

Figure 3-6) constituting said personalized advertisement, said media segment slots including video segment slots and audio segment slots (**Figure 5 item 504 has A/V segments**) , wherein at least one video segment slot overlaps at least one audio segment slot; a plurality of media segments including video segments and audio segments each video segment selectable for insertion into at least one of said video segment slots of said advertisement template (**Figure 6 allows one to choose the placement of data in the disclosed audio and video segments/slots**), wherein several of said video segments are selectable for a same one of said video segment slots of said advertisement template, and wherein each audio segment is selectable for insertion into at least one of said audio segment slots of said advertisement template (**Figure 6 allows one to choose the placement of data in the disclosed audio and video segments/slots**). However, Slade fails to explicitly teach of the plurality of expert rules and of an advertisement assembly component which uses those rules in order to get appropriate media segments for each of said media segment slots of said advertisement.

In an analogous art, Foresman discloses a compiling system that enables recording of individual customized segments. In particular Foresman discloses the use of expert rules in **Col. 6 lines 25-28**. Foresman also discloses an advertisement assembly component, responsive to use profile data of said intended audience, and configured to apply said plurality of expert rules to said user profile data in order to get appropriate media segments for each of said

Art Unit: 2424

media segment slots of said advertisement template from a database and incorporate said appropriate media segments into said advertisement template, in order to assemble said personalized advertisement for said intended audience, said assembly performed without interaction by said intended audience **Col. 5 lines 38-68.**

Therefore it would have been obvious to one of ordinary skill in the art to combine the teachings of Slade and Foresman to devise a system capable of producing individually customized advertisement media that uses expert rules for the benefit of delivering low cost distribution packages to targeted recipients

Regarding Claim 3, Foresman discloses a system wherein said advertisement assembly component also uses environmental or temporal information in order to select appropriate media segments for assembling said personalized advertisement **[Col. 6 lines 41-45]**.

Regarding Claim 4, Slade discloses a system wherein said media segments are selected from the group including audio, video, background, animation, synthesized graphics and voice **[Col. 5 lines 13-25]**.

Regarding Claim 5, Slade discloses a system wherein several of said media segments which correspond to a same one of said media segment slots of said advertisement template are of different lengths, and said advertisement template

appropriately adjusts said personalized advertisement based on a length of a selected one of said media segments **Figure 3**.

Regarding Claim 6 and 12, Official Notice is taken on the limitation of assembling the said customized media presentation immediately before presenting to said intended audience. Both Slade and Foresman system allows for the compilation to be complete before presenting it to the audience. Therefore this limitation would have been an obvious variation to one of ordinary skill in the art.

Regarding Claim 7, Foresman discloses a system wherein said user profile data of said intended audience is obtained from a plurality of user information data sources **[Col. 6 lines 39-43]**.

Regarding Claim 8 and 9, Foresman discloses a wherein said advertisement campaign includes a target entity profile, said target entity profile providing an indication of appropriate media segments for selected user profile data **[Col. 6 lines 20-33]**.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAHAR A. BAIG whose telephone number is (571)270-3005. The examiner can normally be reached on 4/5/9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Kelley/
Supervisory Patent Examiner, Art
Unit 2424

SB